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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			EXAMINER HASHEM, LISA	
			ART UNIT 2614	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/742,190

Applicant(s)

KINNUNEN ET AL.

Examiner

Lisa Hashem

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-14 and 23-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2, 5-14, and 23-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments with respect to claims 1, 2, 5-14, and 23-29 have been considered but are moot in view of the new ground(s) of rejection.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, and 23 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Pat. No. 6,385,305 by Welch.

Regarding claim 1, Welch discloses a communication device (e.g. a mobile user device) (Fig. 1) including a messaging user interface (Fig. 1: 101, 102, 103, 104; col. 2, lines 43-48), the interface being configured for:

selecting a component (e.g. sound, light, a to-do-list, information) for inclusion in a message (e.g. alert) (col. 1, lines 23-42; col. 3, lines 4-15 and lines 20-38),

selecting location conditions (e.g. name of location, coordinates, range) (Fig. 2: 2525, 253, 254) under which the message is enabled to be opened by a device (e.g. PDA, wireless telephone, car phone) of a recipient (e.g. user) (col. 1, lines 23-42; col. 2, line 32 – col. 3, line 4; col. 3, lines 28-38),

Art Unit: 2614

and storing said component as a message together with a message header holding the location conditions under which the message is enabled to be opened by the device of the recipient in a memory of the communication device (Fig. 1, 104; Fig. 2: 260, 261) (col. 2, line 66 – col. 3, line 26; col. 3, lines 28-38).

Regarding claim 2, a device as claimed in claim 1, wherein Welch further discloses in which the message header further contains information descriptive of content of the message (Fig. 2, 263; col. 2, line 66 – col. 3, line 26).

Regarding claim 23, Welch discloses a method comprising:

selecting a component (e.g. sound, light, a to-do-list, information) for inclusion in a message (e.g. alert) at a communications device (e.g. a mobile user device) (Fig. 1) (col. 1, lines 23-42; col. 3, lines 4-15 and lines 20-38);

selecting location conditions (e.g. name of location, coordinates, range) (Fig. 2: 2525, 253, 254) under which the message is enabled to be opened by a device (e.g. PDA, wireless telephone, car phone) of a recipient (e.g. user) (col. 1, lines 23-42; col. 2, line 32 – col. 3, line 4; col. 3, lines 28-38); and

storing said component as a message together with a message header holding the location conditions under which the message is enabled to be opened by the device of the recipient in a memory of the communication device (Fig. 1, 104; Fig. 2: 260, 261) (col. 2, line 66 – col. 3, line 26; col. 3, lines 28-38).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5-8, 10, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Welch, as applied to claim 1, and in further view of U.S. Pat. No. 6,385,305 by Gerszberg et al, hereinafter Gerszberg.

Regarding claim 5, a device as claimed in claim 1 mentioned above, wherein Welch further discloses the message includes a plurality of components (e.g. name, display information) (col. 2, lines 25-29; col. 3, lines 16-38).

Welch discloses a plurality of components. However, Welch does not disclose associated presentation files.

Gerszberg discloses a communication device (Fig. 5; Fig. 1: 10, 130; col. 3, lines 11-16) including a messaging user interface (Fig. 5), the interface being configured for: selecting a component (e.g. object) for inclusion in a message (col. 8, line 7 – col. 9, line 16; col. 11, lines 39-57), selecting conditions (e.g. time and/or date) under which the message may be opened by a device of a recipient (e.g. caller) (col. 6, lines 42-57; col. 9, lines 17-30; col. 10, line 33 – col. 11, line 4) and

Art Unit: 2614

storing said component as a message together at least one of time and date conditions under which the message may be opened by the device of the recipient in the memory (e.g. local storage) of the communication device (Fig. 3B, 173; col. 6, lines 38-41; col. 8, lines 7-12; col. 11, lines 39-57).

Gerszberg further discloses the message includes a plurality of components and associated presentation files (col. 8, line 7 – col. 10, line 5).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the communication device of Welch to include associated presentation files as taught by Gerszberg. One of ordinary skill in the art would have been lead to make such a modification to provide a message to a recipient that includes more than one presentation file (e.g. a video greeting and image) to be presented to the recipient, wherein the presentation files can be gathered from a number of locations within and outside the communication device (e.g. CD ROM, digital video camera, network server platform).

Regarding claim 6, a device as claimed in claim 1 mentioned above, wherein Welch further discloses in which at least one component is an audio file (col. 2, lines 25-29).

Welch does disclose at least one component is a media file (e.g. audio). However, Welch does not disclose at least one component is a multimedia file.

Gerszberg discloses a communication device (Fig. 5; Fig. 1: 10, 130; col. 3, lines 11-16) including a messaging user interface (Fig. 5),  
the interface being configured for:  
selecting a component (e.g. object) for inclusion in a message (col. 8, line 7 – col. 9, line 16; col. 11, lines 39-57),

Art Unit: 2614

selecting conditions (e.g. time and/or date) under which the message may be opened by a device of a recipient (e.g. caller) (col. 6, lines 42-57; col. 9, lines 17-30; col. 10, line 33 – col. 11, line 4) and storing said component as a message together at least one of time and date conditions under which the message may be opened by the device of the recipient in the memory (e.g. local storage) of the communication device (Fig. 3B, 173; col. 6, lines 38-41; col. 8, lines 7-12; col. 11, lines 39-57).

Gerszberg further discloses in which at least one component is a multimedia file (col. 8, line 7 – col. 10, line 5).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the communication device of Welch to include at least one component is a multimedia file as taught by Gerszberg. One of ordinary skill in the art would have been lead to make such a modification to provide a message to a recipient that includes a multimedia file (e.g. a video greeting and image) to be presented to the recipient, wherein the component includes audio, video, and/or text.

Regarding claim 7, a device as claimed in claim 1 mentioned above, wherein Welch discloses the device is configured for creating a presentation file (e.g. audio) associated with said component (col. 2, lines 25-29).

However, Welch does not disclose said file being stored with said message.

Gerszberg discloses a communication device (Fig. 5; Fig. 1: 10, 130; col. 3, lines 11-16) including a messaging user interface (Fig. 5), the interface being configured for:

Art Unit: 2614

selecting a component (e.g. object) for inclusion in a message (col. 8, line 7 – col. 9, line 16; col. 11, lines 39-57),

selecting conditions (e.g. time and/or date) under which the message may be opened by a device of a recipient (e.g. caller) (col. 6, lines 42-57; col. 9, lines 17-30; col. 10, line 33 – col. 11, line 4) and

storing said component as a message together at least one of time and date conditions under which the message may be opened by the device of the recipient in the memory (e.g. local storage) of the communication device (Fig. 3B, 173; col. 6, lines 38-41; col. 8, lines 7-12; col. 11, lines 39-57).

Gerszberg further discloses the device is configured for creating a presentation file associated with said component, said file being stored with said message (col. 8, line 7 – col. 10, line 5; col. 11, lines 39-57).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the communication device of Welch to include said file being stored with said message as taught by Gerszberg. One of ordinary skill in the art would have been lead to make such a modification to provide a message to a recipient that includes a presentation or multimedia file (e.g. a video greeting and image) to be presented to the recipient that is created, wherein the component includes audio, video, and/or text.

Regarding claim 8, a device as claimed in claim 7 mentioned above, wherein Gerszberg further discloses the presentation file contains parameters relating a size and position of a component comprising a video image (col. 8, lines 7-53).

Regarding claim 10, a device as claimed in claim 7 mentioned above, wherein



Art Unit: 2614

Gerszberg further discloses the presentation file contains parameters relating to a color and font of a component inherently comprising a text string (col. 8, lines 7-53).

Regarding claim 13, a device as claimed claim 1 mentioned above, wherein Welch does not disclose including wireless network interface.

Gerszberg discloses a communication device (Fig. 5; Fig. 1: 10, 130; col. 3, lines 11-16) including a messaging user interface (Fig. 5), the interface being configured for: selecting a component (e.g. object) for inclusion in a message (col. 8, line 7 – col. 9, line 16; col. 11, lines 39-57), selecting conditions (e.g. time and/or date) under which the message may be opened by a device of a recipient (e.g. caller) (col. 6, lines 42-57; col. 9, lines 17-30; col. 10, line 33 – col. 11, line 4) and storing said component as a message together at least one of time and date conditions under which the message may be opened by the device of the recipient in the memory (e.g. local storage) of the communication device (Fig. 3B, 173; col. 6, lines 38-41; col. 8, lines 7-12; col. 11, lines 39-57).

Gerszberg further discloses including wireless network interface (col. 4, lines 35-48; col. 4, line 58 – col. 5, line 18).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the communication device of Welch to include a wireless network interface as taught by Gerszberg. One of ordinary skill in the art would have been lead to make such a

Art Unit: 2614

modification to provide a communication device with the capability to communicate to other networks using a wireless network interface.

Regarding claim 14, a device as claimed in claim 1, wherein Welch does not disclose the device is a radio telephone.

Gerszberg discloses a communication device (Fig. 5; Fig. 1: 10, 130; col. 3, lines 11-16) including a messaging user interface (Fig. 5),

the interface being configured for:

selecting a component (e.g. object) for inclusion in a message (col. 8, line 7 – col. 9, line 16; col. 11, lines 39-57),

selecting conditions (e.g. time and/or date) under which the message may be opened by a device of a recipient (e.g. caller) (col. 6, lines 42-57; col. 9, lines 17-30; col. 10, line 33 – col. 11, line 4) and

storing said component as a message together at least one of time and date conditions under which the message may be opened by the device of the recipient in the memory (e.g. local storage) of the communication device (Fig. 3B, 173; col. 6, lines 38-41; col. 8, lines 7-12; col. 11, lines 39-57).

Gerszberg further discloses the device is a radio telephone (e.g. a videophone that uses a radio frequency interface) (col. 4, lines 35-44; col. 4, line 58 – col. 5, line 18; col. 5, lines 24-30).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the communication device of Welch to include the device is a radio telephone as taught by Gerszberg. One of ordinary skill in the art would have been lead to make

Art Unit: 2614

such a modification to provide a communication device that is a radio telephone that includes a radio frequency interface for communication.

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Welch in view of Gerszberg as applied to claim 7, and in further view of Jennings.

Regarding claim 9, a device as claimed in claim 7 mentioned above, wherein Welch discloses an audio recording (col. 2, lines 25-29).

Welch in view of in view of Gerszberg does not disclose the presentation file contains parameters relating to a volume of a component comprising an audio recording.

Jennings discloses a communication device (Fig. 1, 106) including a messaging user interface, the interface configured for selecting a component for inclusion in a message, selecting conditions under which the message may be opened by a device of a recipient (col. 1, lines 32-39; col. 2, lines 36-40; col. 4, lines 5-10; col. 4, line 53 – col. 5, line 14) and storing said component as a message together with a message header in a memory of the communication device (see Abstract; col. 2, line 65 – col. 3, line 36). Wherein Jennings further discloses the presentation file contains parameters relating to a volume of a component comprising an audio recording (col. 1, lines 11-30; col. 4, line 48 – col. 5, line 34).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the communication device of Welch in view of Gerszberg to include the presentation file contains parameters relating to a volume of a component comprising an audio recording as taught by Jennings. One of ordinary skill in the art would have been lead to make such a modification to allow a sender to modify or adjust the volume of the audio recording before sending it to a recipient.

Art Unit: 2614

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Welch as applied to claim 1, and in further view of Jennings.

Regarding claim 11, a device as claimed in claim 1 mentioned above, wherein Welch does not disclose the device is configured for formatting the message as an attachment to a short text message.

Jennings discloses a communication device (Fig. 1, 106) including a messaging user interface, the interface configured for selecting a component for inclusion in a message, selecting conditions under which the message may be opened by a device of a recipient (col. 1, lines 32-39; col. 2, lines 36-40; col. 4, lines 5-10; col. 4, line 53 – col. 5, line 14) and storing said component as a message together with a message header in a memory of the communication device (see Abstract; col. 2, line 65 – col. 3, line 36). Wherein Jennings further discloses means for formatting the message as an attachment to a short text message (see Abstract; col. 5, lines 35-55).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the communication device of Welch to include means for formatting the message as an attachment to a short text message as taught by Jennings. One of ordinary skill in the art would have been lead to make such a modification to allow a sender to attach the message to a short text message.

8. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Welch, as applied to claim 1, and in further view of U.S. Patent No. 6,263,201 by Hashimoto et al, hereinafter Hashimoto.

Regarding claim 12, a device as claimed in claim 1 mentioned above, wherein

Art Unit: 2614

Welch does not disclose the device is configured for formatting the message as an email.

Hashimoto discloses a communication device (e.g. PC; Fig. 1: 51a-51f; col. 4, lines 34-57) including a messaging user interface (Figs. 7-11), the interface being configured for: selecting a component for inclusion in a message (Fig. 11; col. 6, lines 3-53; col. 9, lines 16-60), selecting conditions (e.g. a device on which the message will be opened; pager; portable data terminal) under which the message is enabled to be opened (e.g. displayed) by a device of a recipient (col. 6, lines 12-18; col. 8, lines 35-46; col. 9, lines 37-44; Fig. 10), and storing said component as a message together with a message header holding the conditions under which the message is enabled to be opened by the device of the recipient (Fig. 12) in a memory of a database (Fig. 1, 16; col. 9, lines 37-44; col. 9, line 61 – col. 10, line 2).

Hashimoto further discloses the device is configured for formatting the message as an email (Fig. 13; col. 9, line 61 – col. 10, line 2; col. 10, lines 5-19).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the communication device of Welch to include the device is configured for formatting the message as an email as taught by Hashimoto. One of ordinary skill in the art would have been lead to make such a modification to provide a message to a recipient that is formatted as an email that includes a component that is presented to a recipient.

9. Claims 24, 25, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Welch, as applied to claim 23, and in further view of Gerszberg.

Regarding claims 24, 25, and 27, please see the rejections to the device in claims 7, 8, and 10 above, to reject the method in claims 24, 25, and 27.

Art Unit: 2614

10. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Welch in view of Gerszberg as applied to claim 24, and in further view of Jennings.

Regarding claim 26, please see the rejection to the device in claim 9 above, to reject the method in claim 26.

11. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Welch as applied to claim 23, and in further view of Jennings.

Regarding claim 28 please see the rejection to the device in claim 11 above, to reject the method in claim 28.

12. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Welch as applied to claim 23, and in further view of Hashimoto.

Regarding claim 29, please see the rejection to the device in claim 12 above, to reject the method in claim 29.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 Form.

14. Any response to this action should be mailed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Or faxed to:**

(571) 273-8300 (for formal communications intended for entry)

**Or call:**

(571) 272-2600 (for customer service assistance)

Art Unit: 2614

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (571) 272-7542. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lh  
April 13, 2007

FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

